

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 23, 2007 (the “Office Action”). Claims 8, 20-24 and 46-67 were cancelled in a previous amendment. Claim 19 has been cancelled without prejudice in the present amendment. Claims 1-7, 9-15, 25-27, 29-37, 39-45, and 68-78 remain for consideration.

Section 103 Rejections

In the Office Action, the Examiner rejected Claims 1-7, 9-15, 19, 25-27, 39-45 and 68-78 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,588,732 to Caceres et al. (“Caceres”) in view of U.S. Patent Application Publication 2001/0047741 to Gleeson et al (“Gleeson”). With respect to the rejections as applied to Claim 19, Claim 19 has been cancelled without prejudice in the present amendment and as such, Applicants submit that the rejection with respect to this claim is rendered moot.

The Examiner seeks to combine Caceres with Gleeson and argues that it would have been obvious to modify Caceres’ fiberglass fencing panels to be constructed of the fiber cement building material as taught by Gleeson. The Examiner asserts in the Office Action (page 4) that the motivation is based on the one reference in Gleeson that Gleeson’s fiber cement material has applicability to “building product applications, including...fencing” (see Gleeson [0107]), and also based on Gleeson’s disclosure that its fiber cement material provides “low densities and improved workability at an economical price, as well as improved dimensional stability over that of typical low density additives.” (see Gleeson [0010]).

Applicants respectfully disagree with the Examiner’s assessment of Caceres and Gleeson. At the time the invention was made, there was no motivation to use fiber cement as disclosed in Gleeson in place of the fiberglass fence panels of Caceres. First, the fiberglass materials disclosed in Caceres are vastly different from fiber cement and the materials have different qualities and characteristics. Applicants submit that one of skill in the art would not have been motivated to switch the fiberglass material of Caceres with the fiber cement composition of Gleeson for use in a fencing system. Moreover, it would not have been obvious to cut to size

and shape Caceres' fence pickets prior to curing even if they had in fact been made of fiber cement.

Caceres' fiberglass fence system comprises fence members made of "pultruded fiberglass" in which the elongated members are formed by combining a resin with reinforcing material and then pulling the combination through a die. See Caceres Col. 3, lines 2-5. In forming the fence members, the "plurality of resin-impregnated strands are formed into a unified elongate shape and *drawn though an oven in which the resin is hardened. As each elongated component is drawn out of the oven, it is cut* via means such as that which is known into desired lengths and prepared for transporting. *The ends of each elongate component may also be cut into a desired shape, or capped for a more aesthetically pleasing or smooth appearance.*" Caceres, Col. 3, lines 21-28.

Caceres discloses that the fiberglass components are drawn through an oven and then cured. The fiberglass components are then cut, in the cured state, into desired lengths and shapes. There is no disclosure or suggestion to cut or shape the elongated fiberglass fence components prior to the resin being hardened.

In addition, there would be no reasonable expectation of success in making the Caceres-Gleeson combination. In the event that the fiber cement materials of Gleeson were used in place of the fiberglass materials of Caceres, Caceres contemplates cutting the cured elongated component "into a desired shape, or capped for a more *aesthetically pleasing or smooth appearance.*" Caceres, Col. 3, lines 27-28. It is generally known that when cutting cured fiber cement materials, the side surfaces of the fiber cement that have been exposed to the cutting device may typically exhibit damage. The damage can take the form of visible fraying of the layers, or in the case of fiber cements formed in lamination processes described in Gleeson, such as the Hatschek sheet process (see Gleeson, para. 29, line 1) or hand lay-up (see Gleeson, para. 34, line 1), the damage may manifest as separation of the fiber cement layers. Given that these types of damage detract from the appearance of the fiber cement product, one of skill in the art would not have considered fiber cement to have an "aesthetically pleasing or smooth appearance" as contemplated in Caceres (see Caceres, Col. 3, lines 21-28).

Applicants respectfully submit that one of ordinary skill in the art at the time of Applicants' invention did not contemplate the fiber cement fence systems as being claimed in Applicants' present application, and it was only with this invention that the particular ability to make such fencing systems was made possible. For these reasons, Applicants respectfully request that the rejection of Claims 1-7, 9-15, 19, 25-27, 39-45 and 68-78 over Caceres in view of Gleeson be withdrawn.

In the Office Action, the Examiner also rejected Claims 25-27, 29-33 and 68-78 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 3,801,072 to Newberry ("Newberry") in view of U.S. Patent Application Publication 2001/0047741 to Gleeson et al ("Gleeson"). Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art to employ the fiber cement building material as taught by Gleeson in the fiberglass mold fence panel of Newberry. As noted above, fiberglass is different from fiber cement and the materials have different qualities and characteristics. Applicants submit that one of skill in the art would not have been motivated to switch the fiberglass material of Newberry with the fiber cement composition of Gleeson for use in Newberry's fence mold.

Newberry teaches a fiberglass fence mold which simulates, *but is not in fact*, individual pickets for use in a fence system. According to Newberry, "the fence panel simulates the appearance of a plurality of individual staves...that would appear in a finished fence" (Newberry, Col. 3, lines 60-63). Newberry *teaches away* from employing individual pickets for use in a fence system in that "since hand labor is required to construct wood fences at the site from preformed staves or planks, the total cost of a wood fence is quite excessive." See Newberry Col. 1, lines 18-21. Not only does Newberry not disclose or suggest using individual pickets, Newberry does not disclose or suggest using pickets "comprising fiber cement" and "made into a desired shape for use as a picket prior to curing of said fiber cement, whereby the picket does not exhibit any substantial fraying of the fibers along the front surface, the back surface and the side surfaces after curing" as recited in Applicants' Claim 25 and the claims depending therefrom. As disclosed in Newberry, a primary function of the fence is *decoration*. As noted above, it is generally known that when cutting cured fiber cement materials, the side

surfaces of the fiber cement that have been exposed to the cutting device typically exhibit damage. The damage can take the form of visible fraying of the layers, or in the case of fiber cements formed in lamination processes, the damage may manifest as separation of the fiber cement layers. Given that these types of damage detract from the appearance of the fiber cement product, one of skill in the art would not have considered fiber cement for use in the Newberry fence mold to serve the intended decorative function.

Further, to the extent that Newberry's fence mold discloses that both sides of the produced fence exhibit surface characteristics of the model fence, "two molds will be required." (*See* Newberry, Col. 3, lines 47-51). Newberry describes a lengthy process for forming each of the two required molds, including providing a sheet of fiberglass mat, fiberglass cloth, and polyurethane resin. The composite layer is allowed to "cure for approximately 24 hours" Thereafter, two layers of fiberglass mat and one layer of fiberglass cloth are positioned over the first layer...and again saturated with polyurethane resin. "The composite layer is then allowed to cure for another 24 hours." *See* Newberry, Col. 2, line 41-59. In addition to there being no motivation or suggestion to combine Newberry and Gleeson, the cited references do not teach all the claim limitations. For example, neither reference discloses "a picket for use in a fence system comprising fiber cement" "wherein the picket has a pattern formed on the front surface and back surface of the picket, the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously by two embossing rollers" as recited in Applicants' independent claims 25 and 68.

Further, neither reference discloses a fence system comprising "a plurality of individual pickets each having an elongated configuration extending between an upper end and a lower end, wherein each individual picket is spaced from another of the individual pickets by a distance of between $\frac{1}{2}$ and 1 inch, each picket being made of fiber cement" as recited in Applicants' claim 34. In fact, Newberry's molded fence would not even be based on fences with spaced-apart pickets in that "care must be exercised in selecting materials for the model panel. If the panel is a wood fence, the staves must be selected for a relative close fit." *See* Newberry, Col. 2, lines

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11-15. Newberry cautions that the "junctions between the individual components [of the to-be-modeled fence] should be relatively *continuous*." See Newberry Col. 4, 47-49.

Based on the foregoing, Applicants respectfully submit that one of ordinary skill in the art at the time of Applicants' invention did not contemplate the fiber cement fence system as being claimed in Applicants' present application. Applicants respectfully request that the rejection of Claims 25-27, 29-33 and 68-78 under Section 103 over Newberry in view of Gleeson be withdrawn.

For these reasons, Applicants respectfully request that the Examiner withdraw the rejections of the claims under § 103.

CONCLUSION

In light of the amendments and remarks set forth above, Applicants respectfully submit that the Application is now in allowable form. Accordingly, Applicants respectfully request consideration and allowance of the currently pending claims. It is believed that no additional fees are due at this time. If this is incorrect, Applicants hereby authorize the Commissioner to charge any fees, other than issue fees, that may be required by this paper to Deposit Account No. 07-0153. The Examiner is respectfully requested to call Applicants' Attorney for any reason that would advance the current application to issue.

Respectfully submitted,



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April 23, 2007

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